

DISCUSSION OF THE AMENDMENT

Due to the length of the specification herein, Applicants will cite to the paragraph number of the published patent application (PG Pub) of the present application, i.e., US 2006/0201645, when discussing the application description, both in this section and in the Remarks section, *infra*, rather than to page and line of the specification as filed.

Claims 1 and 6 have been amended by excluding the presence of an acidic rosin emulsion sizing agent, as supported in the specification at paragraph [0080], wherein such a component is optional. See *In re Johnson*, 558 F.2d 1008, 194 USPQ 187 (CCPA 1977) (**copy enclosed**) (holding that a claim to a genus with a recital of a negative proviso that did not appear in the specification complied with the description requirement.)

New Claims 8-18 have been added. Claims 8 and 9 are supported in the specification at paragraph [0058]. Claims 10 and 11 are supported in the specification at paragraph [0057]. Claim 12 is supported in the specification at paragraph [0073]. Claims 13 and 14 are supported in the specification at paragraph [0084]. Claims 15 and 16 are supported in the specification at paragraph [0085]. Claims 17 and 18 are supported in the specification at paragraph [0086].

No new matter is believed to have been added by the above amendment. Claims 1-18 are now pending in the application.

REMARKS

The rejection of Claims 1-7 under 35 U.S.C. § 103(a) as unpatentable over *Animated Poly-N-Vinylformamide as a Modern Retention Aid of Alkaline Paper Sizing with Acid Rosin Sizes* (Wang et al) in view of US 6,566,470 (Kantamneni et al), is respectfully traversed.

As described in the specification beginning at paragraph [0001], it is known to add oil-proofing agents in the production of paper, but it is difficult to produce paper where the oil resistance, wet strength and water resistance, and the drainage at the time of production is enhanced, all at the same time. Applicant successfully addresses this problem by the inclusion of a particular fixing agent as recited in the claims.

Wang et al discloses partially aminated poly-N-vinylformamides (APNVF) as a retention aid of alkaline paper sizing with acid rosin sizes. Kantamneni et al has been relied for a disclosure of particular anionic fluorine-based oil-proofing agents. The Examiner holds that it would have been obvious to substitute the acid rosin size of Wang et al with the anionic fluorine-based oil-proofing agent of Kantamneni et al.

In reply, Wang et al's disclosure is specific to acid rosin sizes. It would not have been reasonably predictable what effect, if any, the APNVF would have on non-acid rosin sizes, which are now excluded by the present claims. Clearly, one of ordinary skill in the art would use APNVF **only** with acid rosin sizes. Accordingly, it is respectfully requested that this rejection be withdrawn.

The rejection of Claims 1-7 under 35 U.S.C. § 103(a) as unpatentable over EP 0280115 (Aoyama et al) in view of Wang et al, is respectfully traversed. Aoyama et al discloses an oil proof composition for paper comprising at least one salt selected from the group consisting of fluoroalkyl phosphate salts, N-alkyl fluoroalkanesulfonamidoalkyl phosphate salts and fluoroalkenyloxyaralkyl phosphonate salts and at least one anionic

surfactant (page 2, lines 34-37). Aoyama et al additionally discloses the inclusion of a “bonding agent” (page 3, lines 50-54).

Acknowledging that Aoyama et al does not disclose the presently-recited fixing agent, the Examiner relies on Wang et al. The Examiner holds that it would have been obvious to one of ordinary skill in the art to substitute the APNVF of Wang et al for the bonding agent disclosed by Aoyama et al.

In reply, what has been stated above with regard to Wang et al applies herein as well. Wang et al is specific to acid rosin sizes, which are excluded from the present claims. Thus, even if the bonding agent of Aoyama et al would be understood to mean a fixing agent, it would not have been obvious to one of ordinary skill in the art to use the APNVF of Wang et al in place of the bonding agent of Aoyama et al. Accordingly, it is respectfully requested that this rejection be withdrawn.

All of the presently-pending claims in this application are now believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

Customer Number

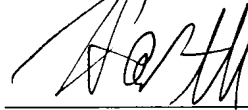
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